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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/095,365	06/10/98	KAKINUMA	T 163852016000

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MORRISON & FOERSTER  
BARRY E BRETSCHNEIDER  
2000 PENNSYLVANIA AVENUE NW  
WASHINGTON DC 20006-1888

EXAMINER

GRAY, L

ART UNIT	PAPER NUMBER
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1734

*11*

DATE MAILED:

09/18/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/095,365

Applicant(s)  
Kakinuma et al.

Examiner  
Linda L. Gray

Group Art Unit  
1734



☒ Responsive to communication(s) filed on 2-23-00

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-13 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-13 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☒ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

# Interview Summary

Application No.  
09/095,365

Applicant(s)  
Kakinuma et al.

Examiner  
Linda L. Gray

Group Art Unit  
1734



All participants (applicant, applicant's representative, PTO personnel):

(1) Linda L. Gray (3) ---  
(2) Mr. Brown (4) ---

Date of Interview 9-7-00

Type: ☒ Telephonic ☐ Personal (copy is given to ☐ applicant ☐ applicant's representative).

Exhibit shown or demonstration conducted: ☐ Yes ☒ No. If yes, brief description:

Agreement ☐ was reached. ☐ was not reached. n/a

Claim(s) discussed: 12 and 13

Identification of prior art discussed:  
None

Description of the general nature of what was agreed to if an agreement was reached, or any other comments:

The Examiner indicated that upon further review of claims 12-13, a nonfinal Office action which reopens prosecution of the application will be mailed.

(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

1. ☒ It is not necessary for applicant to provide a separate record of the substance of the interview.

Unless the paragraph above has been checked to indicate to the contrary, A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a response to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW.

2. ☐ Since the Examiner's interview summary above (including any attachments) reflects a complete response to each of the objections, rejections and requirements that may be present in the last Office action, and since the claims are now allowable, this completed form is considered to fulfill the response requirements of the last Office action. Applicant is not relieved from providing a separate record of the interview unless box 1 above is also checked.

Linda L. Gray 9-7-00

Examiner Note: You must sign and stamp this form unless it is an attachment to a signed Office action.

LINDA L. GRAY  
PATENT EXAMINER  
ART UNIT 1734

**DETAILED ACTION**

**Status of Application**

1. The indicated allowability of claims 12-13 is withdrawn. A rejection for claims 12-13 follows.

**Claim Rejections - 35 USC § 112**

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. **Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.**

**Claim 1** includes "without requiring sensors to activate the cutter" which is not supported in the original application. Although the original application is silent on the use of sensors for the cutter, silence is not considered support, Ex Parte Graselli 231 USPQ 393. The same applies to the amendment to **claim 11** of "without an alignment assembly".

4. **Claims 4 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.**

**Claim 4**, "may be changed" (L 2) renders claim 4 indefinite because it is not clear if the limitation that follows is required or not. **Claim 6**, use of "the exchange of the tape" (L 2-3) renders claim 6 indefinite because there is insufficient antecedent basis for this limitation.

**Claim Rejections - 35 USC § 102**

5. **Claims 1-2, 4, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Clark, Jr. et al. (US 4,966,644).**

**Claims 1 and 11**, Clark, Jr. et al. (Clark et al.) teach a sheet sorting apparatus for adhering marker 3 to predetermined sheet 4 including (a) tape feeder 38 for pulling out tape 13 having heat/pressure

sensitive adhesive 15 on one side edge 17, **(b)** cutter 39 for making marker 3 by cutting tape 13 at a preset length (c 4, L 56-60), **(c)** guide 35 for positioning marker 3 to a predetermined position on sheet 4, and **(d)** marker-and-sheet-feeder 41 for feeding marker 3 and sheet 4 in partially overlapping position wherein marker 3 is adhered to sheet 4 by a predetermined pressure force (caused by rollers 108/109) as they pass through feeder 41 (p 4, L 34, to p 12, L 37).

The claim limitation of "being output by an image processing apparatus" (L 2) is an intended use of the sheet sorting apparatus (i.e., use the sheet sorting apparatus with an image processing apparatus). There is nothing in the claims that requires the sheet sorting apparatus to be used with an imaging processing apparatus. The new matter has not been considered.

**Claim 2**, marker 3 is adhered to an underside of sheet 4 in that marker 3 is adhered to the back (Fig 13). **Claim 4**, Clark et al. do not teach that the adhering position is changeable where use of the language "may" in claim 4 means that the adhering position can change but does not have to change.

### **Claim Rejections - 35 USC § 103**

**6. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark, Jr. et al. in view of Applicants' admitted prior art.**

**Claim 12**, Clark et al. teach using the sheet sorting apparatus in combination with an image processing apparatus at column 1, lines 11-21. Sheets 4 are manually placed in holder 115 for feeding to the sheet sorting apparatus.

**Claim 12**, the difference between claim 12 and Clark et al. is that Clark et al. do not teach that the image processing apparatus feeds sheets 4 to the sheet sorting apparatus.

However, Applicants' admitted prior art (AAPA) teaches that it is conventional for an imaging processing apparatus to include a sheet sorting apparatus where the image processing apparatus feeds the sheets to the sheet sorting apparatus. The sheets are then placed on a tray (pg 1, L 9, to p 2, L 11).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Clark et al. that the image processing apparatus feeds sheets 4 to the sheet sorting apparatus because AAPA teaches that it is convention to provide an imaging processing apparatus in combination with a sheet sorting apparatus that feeds the sheets to the sheet sorting apparatus where such a combination in Clark et al. would eliminate the manual labor of collecting sheets 4 from the image

processing apparatus and placing sheets 4 manually into holder 115.

**Claim 13**, Clark et al. modified do not teach that at least one side of the tray is lower than the middle of the tray (i.e., tilted).

It is conventional to provide a tilted tray for receiving sheets from a sheet sorting apparatus because tilted trays aid in lining up the sheets correctly along a given side.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Clark et al. modified that at least one side of the tray is lower than the middle of the tray (i.e., tilted) because it is conventional to provide a tilted tray for receiving sheets from a sheet sorting apparatus because tilted trays aid in lining up the sheets correctly along a given side.

**7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark, Jr. et al. in view of Vonderhorst et al. (US 5,556,492).**

*Claim 5, the difference between claim 5 and Clark et al. is that Clark et al. do not teach a sensor for marker 3 in a forward position of the apparatus.*

Vonderhorst et al. teach the necessity of a sensor for a marker in a forward position of a label producing apparatus such that feed of the web material to make the marker can be halted when necessary. Sensor 52 for labels 14 in a forward position of a label producing apparatus is used such that the feed of web 12 to make labels 14 can be halted when necessary (c 2, L 28-30; c 3, L 54-60; c 6, L 38-51).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Clark et al. a sensor for marker 3 in a forward position of the apparatus because Vonderhorst et al. teach the necessity of a sensor for a marker in a forward position of a label producing apparatus such that feed of the web material to make the marker can be halted when necessary where unnecessary feed of the web material would cause backup of the web in the apparatus.

**8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark, Jr. et al. in view of Nobile et al. (US 5,390,594).**

*Claim 6, the difference between claim 6 and Clark et al. is that Clark et al. do not teach a tape end detector on the path of tape 13 for signaling tape 13 exchange.*

Nobile et al. teaches the necessity of a tape end detector on the path of a tape for signaling tape

exchange so that the machine operating on the tape does not continue to operate unnecessarily. Detector 216 performs this operation (c 1, L 49-52; c 2, L 34-43; c 3, L 35-58; c 11, L 13, to c 12, L 29).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Clark et al. a tape end detector on the path of tape 13 for signaling tape 13 exchange because Nobile et al. teaches the necessity of having a tape end detector on the path of a tape for signaling tape exchange so that the machine operating on the tape does not continue to operate unnecessarily.

**9. Claims 1-2, 4, 7-8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Busk (US 3,245,859) in view of Lowe et al. (US 3,926,713).**

**Claims 1 and 11**, Busk teaches a sheet sorting apparatus for adhering marker E to predetermined sheet D including **(a)** a tape feeder for pulling out tape K of plastic, **(b)** cutter 73/75 for making marker E by cutting tape K at a preset length, **(c)** guide N for positioning marker E to a predetermined position on sheet D, and **(d)** marker-and-sheet-feeder R for feeding marker E and sheet D in partially overlapping position (partially overlaps on one side and partially overlaps on the other side) wherein marker E is adhered to sheet D by a predetermined pressure force as they pass through feeder R, using heat (c 2, L 48, to c 5, L 47). Cutter 73/75 does not require sensors for activation.

The claim limitation of "being output by an image processing apparatus" is an intended use of the sheet sorting apparatus (i.e., use the sheet sorting apparatus with an image processing apparatus). There is nothing in the claims that requires the sheet sorting apparatus to be used with an imaging processing apparatus.

*The difference between claims 1 and 11 and Busk is that Busk does not teach that marker E has pressure sensitive adhesive on the bonding edges.*

Lowe et al. teach a sheet sorting apparatus for adhering marker 53 to predetermined sheet 38 including **(a)** a tape feeder for pulling out tape 76 of plastic along or plastic having pressure sensitive adhesive on the bonding edges, **(b)** cutter 78' for making marker 53 by cutting tape 76 at a preset length, and **(c)** guide 79 for positioning marker 53 to a predetermined position on sheet 38 wherein marker 53 is adhered to sheet 38 by a predetermined pressure force, using heat (c 2, L 23, to c 10, L 51).

It would have been obvious to a person of ordinary skill in the art at the time the invention was

made to have provided in Busk that marker E has a pressure sensitive adhesive on the bonding edges because Lowe et al. teach that such is a conventional alternative to plastic alone and it is obvious to replace one type of tab-tape (that of Busk) with another art recognized alternative type of tab-tape (that of Lowe et al.).

**Claim 2**, marker E is adhered to an underside of sheet D.

**Claim 4**, *Busk does not teach that the adhering position is changeable where use of the language "may" in claim 4 means that the adhering position can change but does not have to change. In any event, if "may" means to change the position, Lowe et al. teach that such is possible using solenoids 40, 41, and 42 so that one can place marker 53 as desired or necessary.*

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Busk that the adhering position is possible because Lowe et al. teach making the adhering position of a tab possible gives one the freedom of placing the marker as desired or necessary.

**Claims 7-8**, *the difference between claims 7-8 and Busk modified is that Busk modified does not teach a single motor for driving the feeder, cutter 73/75, guide N, and feeder R.*

It is convention to use one motor to operate several items of an apparatus in order to save on the cost of purchasing more than one motor, and it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Busk modified single motor for driving the feeder, cutter 73/75, guide N, and feeder R in order to save on the cost of purchasing more than one motor.

**10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Busk in view of Lowe et al. as applied to claims 1-2, 4, 7-8, and 11 and further in view of Vonderhorst et al.**

**Claim 5**, *the difference between claim 5 and Busk modified is that Busk modified does not teach a sensor for marker E in a forward position of the apparatus.*

In view of Vonderhorst et al., it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Busk modified a sensor for marker E in a forward position of the apparatus because Vonderhorst et al. teach the necessity of a sensor for a marker in a forward position of a label producing apparatus such that feed of the web material to make the marker can be halted when necessary where unnecessary feed of the web material would cause backup of the web in the apparatus.



**11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Busk in view of Lowe et al. as applied to claims 1-2, 4, 7-8, and 11 above, and further in view of Nobile et al.**

*Claim 6, the difference between claim 6 and Busk modified is that Busk modified does not teach a tape end detector on the path of tape K for signaling tape K exchange.*

In view of Nobile, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Busk modified a tape end detector on the path of tape K for signaling tape K exchange because Nobile et al. teaches the necessity of having a tape end detector on the path of a tape for signaling tape exchange so that the machine operating on the tape does not continue to operate unnecessarily.

**12. The indicated allowability of claims 3 and 9-10 is withdrawn in view of the newly discovered reference to Busk modified in view of Cavender (US 4,070,220), necessitated by amendment because of the new matter added to claims 1 and 11 and because of the correction of the objection to claims 4-6. Rejections based on the newly cited reference follows:**

**Claims 3 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Busk in view of Lowe et al. as applied to claims 1-2, 4, 7-8, and 11 above, and further in view of Cavender (US 4,070,220).**

*Claim 3, the difference between claim 3 and Busk modified is that Busk modified does not teach a printer for markers E having a printer controller to apply the same indicia/color pattern to markers E.*

It is conventional to provide a printer for labels clearly having a printer controller of some kind to apply the same indicia/color pattern to the labels where the labels can be mass produced. This is also demonstrated by Cavender.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Busk modified a printer for marker E having a controller to apply the same indicia/color pattern to markers E because it is conventional to provide a printer for labels clearly having a printer controller of some kind to apply the same indicia/color pattern to the labels so that the labels can be mass produced.

*Claims 9-10, the difference between claim 9 and Busk modified is that Busk modified does not teach an inkjet printer (claim 9) or stamper (claim 10).*

An ink jet printer and a stamper are conventional in the art. Note that Cavender does not restricted

the printer to any one specific kind but indicates use of a "suitable" printer.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Busk modified an inkjet printer or stamper because an inkjet printer and a stamper are conventional printers, and it is obvious to replace one type of printer (that of Busk, modified, not specifically disclosed) with another art recognized alternative printer.

### **Response to Arguments**

**13.** Applicants' arguments filed 2-23-00 have been fully considered. Applicants' comments concerning the amendment to claim 1 of "without requiring sensors to activate the cutter" and the amendment to claim 11 of "without an alignment assembly" are noted. In response, these limitations are new matter. Applicants' comment with respect to the prior art rejection of claims 7-8 over Clark et al. is noted; in response, claims 7-8 have been removed from the prior art rejection over Clark et al.

The new abstract has been entered. The amendment to the specification has been entered. The amendments to the claims have been entered. The supplemental declaration has been entered. The Examiner has located support for the amendments to the claims at the location indicated by Applicants; further, support for the amendment to claim 2 is found at page 12, lines 1-8, and Figure 9.

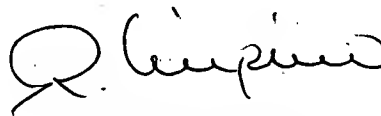
### **Conclusion**

**14.** Any inquiry concerning this communication or earlier communications should be directed to Examiner Linda L. Gray at (703)308-1093, Monday-Friday from 6:30 am to 3:30 pm. The necessary fax numbers are (703)305-7718 (official), (703)305-7115 (unofficial), and (703)305-3599 (after final).

llg 

September 13, 2000

  
Linda L. Gray  
Patent Examiner



RICHARD CRISPINO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700